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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,443	12/19/2003	Jose Luis Moctezuma Barrera	29997/065	1735
29471	7590	10/26/2010		
MCCRACKEN & FRANK LLP				EXAMINER
311 S. WACKER DRIVE				RAJ, RAJIV J
SUITE 2500			ART UNIT	PAPER NUMBER
CHICAGO, IL 60606				3686
			MAIL DATE	DELIVERY MODE
			10/26/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/743,443	BARRERA, JOSE LUIS MOCTEZUMA
<b>Examiner</b>	<b>Art Unit</b>	
RAJIV J. RAJ	3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 July 2010.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 16,18,20-27,29,30,35 and 37-50 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 16,18,20-27,29-30,35 & 37-50 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. This action is in reply to the amendment filed on 26 July 2010.
2. Claims 16,18, 22,25,27,30 & 35 have been amended.
3. Claims 1-15, 17,19,28, 31-34 & 36 has been canceled.
4. Claims 37-50 have been added.
5. Claims 16, 18, 20-27, 29,30,35 37-50 are currently pending and have been examined.

### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. The 35 U.S.C. 101 rejection for claims 1-15 and 35-36 have been withdrawn in light of applicant's amendment.
8. Claims 35, 37-50 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, a § 101 process should (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88

(1876). The process steps in claim (1) are not tied to a machine nor do they effect any transformation of matter. Thus, they are considered non-statutory.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 16 recites the limitation "*the consequent step*". There is insufficient antecedent basis for this limitation in the claim.

11. Claims 16 & 37 (and all claims dependent on these claims) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the Office what "*identifying the consequent step*" mean, and further what step is being identified or what step is the consequent step. Thus the Office will interpret this limitation as any step in the prior art that assesses steps in multi-step medical procedures.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 16,18, 20-27, 29,30,35 37-50are rejected under 35 U.S.C. 103(a) as being unpatentable over Malackowski et al. (US 2003/0093103 A1) (hereinafter Malackowski) in view Van Der Brug (US 5954648) (hereinafter Van Der Brug) of in further view of DiGioia et al. (US 6205411 B1) (hereinafter DiGioia).

### **Claim 16**

**Malackowski as shown, discloses the following limitations:**

- *means for identifying a component usable in the multi-step surgical procedure;* (see at least Malackowski [0045])
- *means for analyzing steps of the surgical procedure including a step other than the current step or an immediately subsequent step in the first sequence;* (see at least Malackowski Claim:19 Fig:21 Items:350 & related text)
- *means for identifying the consequent step as the first step analyzed for which the component is acceptable;* (see at least Malackowski [0154-0158])

Malackowski does not disclose the following limitations, however Van Der Brug, as shown, does:

- *means for automatically jumping to and displaying representation related to the consequent step without direct interaction between a user and the computer navigation system; (see at least Van Der Brug Fig. Items 4,5,8 & related text)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the limitations of Van Der Brug to Malackowski with the motivation to provide an improved method and system for image guided multi-step medical procedure invention. (see at least Van Der Brug Column:1 Lines:50-67 Column:2 Lines:1-67 Column:3 Lines:1-47)

While Malackowski/Van Der Brug does not specifically disclose "*automatically jumping to and . . . without direct interaction between a user and a computer system*", Examiner points out that as discussed in MPEP § 2144, if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. Examples directed to various common practices which the court has held normally require only ordinary skill in the art and hence are considered routine expedients are discussed below. If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.

*In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve

system to release the inner core after a predetermined time has elapsed." The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.

"The routine addition of modern electronics to an otherwise unpatentable invention typically creates a *prima facie* case of obviousness. Moreover, there is no pertinent evidence of secondary considerations because the only evidence offered is of long-felt need for the unpatentable mental process itself, not long-felt need for the combination of the mental process and a modern communication device or computer." *In re Comiskey*, 499 F. 3d 1365, 84 U.S.P.Q. 2d 1670 (Fed. Cir. 2007)

Malackowski/Van Der Brug do not disclose the following limitation, however DiGioia, as shown, does:

- *means for identifying a current step within the multi-step procedure;* (see at least DiGioia [0131])

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the feature of DiGioia into Malackowski/Van Der Brug with the motivation to provide an improved method and system for assessing, identifying, and planning the appropriate steps for a medical procedure. (see at least DiGioia Column:5 Lines: 57-67 Column:6 Lines:1-8)

### **Claim 18**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 16. Van Der Brug further discloses the following limitation:

- *means for identifying a particular location of the component, and means for identifying the consequent step based on the location;* (see at least Van De Berg Column:3&4 Lines:57-60 & 2-6)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the limitations of Van Der Brug to Malackowski/Van Der Brug/DiGioia with the motivation to provide an improved method and system for image guided multi-step medical procedure invention. (see at least Van Der Brug Column:1 Lines:50-67 Column:2 Lines:1-67 Column:3 Lines:1-47)

#### **Claim 20**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 16. Van Der Brug further discloses the following limitation:

- *the component is a multipart component capable of self identifying the component's composite parts* (see at least Van De Berg Fig. Items:1,3,10 & related text)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the limitations of Van Der Brug to Malackowski/Van Der Brug/DiGioia with the motivation to provide an improved method and system for image guided multi-step medical procedure invention. (see at least Van Der Brug Column:1 Lines:50-67 Column:2 Lines:1-67 Column:3 Lines:1-47)

#### **Claim 21**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 20. Van Der Brug further discloses the following limitation:

- *the multipart component is a tool with an attached device wherein the tool can identify the attached device* (see at least Van De Berg Fig. Items:1,3,10 & related text)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the limitations of Van Der Brug to Malackowski/Van Der Brug/DiGioia with the motivation to provide an improved method and system for image guided multi-step medical procedure invention. (see at least Van Der Brug Column:1 Lines:50-67 Column:2 Lines:1-67 Column:3 Lines:1-47)

### **Claim 22**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 20. Van Der Brug further discloses the following limitation:

- *the multipart component is a tool with an attached device wherein the attached device is separately identifiable* (see at least Van De Berg Figure Items:1,3,10)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the limitations of Van Der Brug to Malackowski/Van Der Brug/DiGioia with the motivation to provide an improved method and system for image guided multi-step medical procedure invention. (see at least Van Der Brug Column:1 Lines:50-67 Column:2 Lines:1-67 Column:3 Lines:1-47)

### **Claim 23**

The combination Van Der Brug/Malackowski/DiGioia discloses all the limitations of Claim 18. Van Der Brug further discloses the following limitation:

- *means for identifying a particular location of the component* (see at least Van Der Brug Column:3 Lines:57-65 Column:4 Lines:1-4)

- *component is incorporated within the computer navigation system.* (see at least Van De Berg Column:1 Lines:52-58 and Figure & related text)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the limitations of Van Der Brug to Malackowski/Van Der Brug/DiGioia with the motivation to provide an improved method and system for image guided multi-step medical procedure invention. (see at least Van Der Brug Column:1 Lines:50-67 Column:2 Lines:1-67 Column:3 Lines:1-47)

#### **Claim 24**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 16. Malackowski further discloses the following limitation:

- *means for configuring the consequent step with a parameter of the component.* (see at least Malackowski [0077])

#### **Claim 25**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 16. Malackowski further disclose the following limitation:

- *the consequent step comprises a warning that the component is inappropriate for any step that is analyzed;* (see at least Malackowski [0078])

#### **Claim 26**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 16. Van Der Brug further discloses the following limitation:

- *the consequent step includes controlling a piece of auxiliary apparatus.* (see at least Van De Berg Column:4 Lines:44-46)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the limitations of Van Der Brug to Malackowski/Van Der Brug/DiGioia with the motivation to provide an improved method and system for image guided multi-step medical procedure invention. (see at least Van Der Brug Column:1 Lines:50-67 Column:2 Lines:1-67 Column:3 Lines:1-47)

### **Claim 27**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 16. Malackowski further discloses the following limitations:

- *means for identifying an additional component and* (see at least Malackowski [0165])
- *means for determining the consequent step based on the identity of the additional component,* (see at least Malackowski [0087])

### **Claim 29**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 16. Van Der Brug further discloses the following limitation:

- *the multi-step surgical procedure is a computer controlled and directed surgical procedure;*  
(see at least Van De Berg Column:1 Lines:26-30)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the limitations of Van Der Brug to Malackowski/Van Der Brug/DiGioia with the motivation to provide an improved method and system for image guided multi-step medical procedure invention. (see at least Van Der Brug Column:1 Lines:50-67 Column:2 Lines:1-67 Column:3 Lines:1-47)

**Claim 30**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 16. Malackowski further discloses the following limitations:

- *a database of user preferences and (see at least Malackowski [0072])*
- *means for determining the consequent step based on the database; (see at least Malackowski [0087])*

**Claim 35**

**Malackowski as shown, discloses the following limitations:**

- *identifying a component usable in at least one step of the procedure; (see at least Malackowski [0045])*
- *analyzing whether the component is acceptable for use in steps of the surgical procedure including a step other than the current step or an immediately subsequent step in the first sequence; (see at least Malackowski [0154-0158] Claim:19 Fig:21 Items:350 & related text)*
- *within a field of tracking of the computer navigation system; (see at least Malackowski Fig:21 Items:350 & related text)*
- *determining the consequent step based on the location, the identity of the component, and the identity of the current step; (see at least Malackowski [0087])*
- *based on the determination of the consequent step; (see at least Malackowski Claim:15 & 16)*

Malackowski does not disclose the following limitations, however Van Der Brug, as shown, does:

- *identifying a location of the component;* (see at least Van Der Brug Column:1 Lines:23-67 Column:2 Lines:1-50 Column: 3, line 57 to column 4, line 6)
- *displaying a representation related to the consequent step on a display unit;*  
(see at least Van Der Brug Fig. Items 4,5,8 & related text)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the limitations of Van Der Brug to Malackowski/Van Der Brug/DiGioia with the motivation to provide an improved method and system for image guided multi-step medical procedure invention. (see at least Van Der Brug Column:1 Lines:50-67 Column:2 Lines:1-67 Column:3 Lines:1-47)

Van Der Brug/Malackowski do not disclose the following limitation, however DiGioia, as shown, does:

- *identifying a current step of the multi-step procedure;* (see at least DiGioia [0131])

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the feature of DiGioia into Van Der Brug/Malackowski with the motivation to provide an improved method and system for assessing, identifying, and planning the appropriate steps for a medical procedure. (see at least DiGioia Column:5 Lines: 57-67 Column:6 Lines:1-8)

### **Claim 37**

**Malackowski as shown, discloses the following limitations:**

- *identifying a component being tracked by the computer navigation system that is to be utilized in at least one step of the surgical procedure; (see at least Malackowski [0045] Fig:21 Items:350 & related text)*
- *analyzing steps of the surgical procedure including a step other than the current step or an immediately subsequent step in the first sequence; (see at least Malackowski Claim:19 Fig:21 Items:350 & related text)*
- *identifying the consequent step as the first step analyzed for which the component is acceptable; (see at least Malackowski [0154-0158])*

Malackowski does not disclose the following limitations, however Van Der Brug, as shown, does:

- *automatically jumping to the consequent step and displaying a representation related to the consequent step on a display unit; (see at least Van Der Brug Fig. Items 4,5,8 & related text)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the limitations of Van Der Brug to Malackowski with the motivation to provide an improved method and system for image guided multi-step medical procedure invention. (see at least Van Der Brug Column:1 Lines:50-67 Column:2 Lines:1-67 Column:3 Lines:1-47)

Malackowski/Van Der Brug do not disclose the following limitation, however DiGioia, as shown, does:

- *identifying a current step of the surgical procedure;* (see at least DiGioia [0131])

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the feature of DiGioia into Malackowski/Van Der Brug with the motivation to provide an improved method and system for assessing, identifying, and planning the appropriate steps for a medical procedure. (see at least DiGioia Column:5 Lines: 57-67 Column:6 Lines:1-8)

### **Claim 38**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 37. Malackowski further discloses the following limitation:

- *the steps of the surgical procedure are analyzed according to a second sequence, wherein the second sequence depends upon the identity of the current step.* (see at least Malackowski [0077,0154-0158])

### **Claim 39**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 38. Malackowski further discloses the following limitation:

- *the second sequence comprises analyzing the current step, analyzing a prior step after analyzing the current step, and analyzing a future step after analyzing the prior step;* (see at least Malackowski Fig:21 Items:350 & related text)

### **Claim 40**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 38. Malackowski further discloses the following limitation:

- *the second sequence includes every step of the surgical procedure;* (see at least Malackowski Fig:21 Items:350 & related text)

#### **Claim 41**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 37. Malackowski further discloses the following limitation:

- *tracking a position of the component within a surgical field;* (see at least Malackowski Claim:15)

Malackowski does not disclose the following limitation, however Van Der Brug, as shown, does:

- *wherein the consequent step is identified based on the position of the component;* (see at least Van De Berg Column:4 Lines:44-46 Claim:11)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the limitations of Van Der Brug to Malackowski with the motivation to provide an improved method and system for image guided multi-step medical procedure invention. (see at least Van Der Brug Column:1 Lines:50-67 Column:2 Lines:1-67 Column:3 Lines:1-47)

#### **Claim 42**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 37. Van Der Brug further discloses the following limitation:

- *the component is a multipart component capable of self-identifying composite parts of the multipart component to the computer navigation system; (see at least Van De Berg Column: 3, line 57 to column 4, line 6)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the limitations of Van Der Brug to Malackowski/Van Der Brug/DiGioia with the motivation to provide an improved method and system for image guided multi-step medical procedure invention. (see at least Van Der Brug Column:1 Lines:50-67 Column:2 Lines:1-67 Column:3 Lines:1-47)

#### **Claim 43**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 42. Van Der Brug further discloses the following limitation:

- *the multipart component comprises a tool with an attached device, wherein the tool can identify the attached device; (see at least Van De Berg Fig: Items:1-10 & related text)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the limitations of Van Der Brug to Malackowski/Van Der Brug/DiGioia with the motivation to provide an improved method and system for image guided multi-step medical procedure invention. (see at least Van Der Brug Column:1 Lines:50-67 Column:2 Lines:1-67 Column:3 Lines:1-47)

#### **Claim 44**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 42. Van Der Brug further discloses the following limitation:

- *the multipart component is a tool with an attached device, wherein the attached device is separately identifiable;* (see at least Van De Berg Fig: Items:1-10 & related text)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the limitations of Van Der Brug to Malackowski/Van Der Brug/DiGioia with the motivation to provide an improved method and system for image guided multi-step medical procedure invention. (see at least Van Der Brug Column:1 Lines:50-67 Column:2 Lines:1-67 Column:3 Lines:1-47)

#### **Claim 45**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 37. Malackowski further discloses the following limitation:

- *configuring the consequent step with a parameter of the component;* (see at least Malackowski [0077])

#### **Claim 46**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 37. Malackowski further discloses the following limitation:

- *the consequent step comprises a warning that the component is inappropriate for any step that is analyzed;* (see at least Malackowski [0078])

#### **Claim 47**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 37. Van Der Brug further discloses the following limitation:

- *the consequent step includes controlling a piece of auxiliary apparatus. (see at least Van De Berg Column:4 Lines:44-46)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the limitations of Van Der Brug to Malackowski with the motivation to provide an improved method and system for image guided multi-step medical procedure invention. (see at least Van Der Brug Column:1 Lines:50-67 Column:2 Lines:1-67 Column:3 Lines:1-47)

#### **Claim 48**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 37. Malackowski further discloses the following limitation:

- *identifying a second component that is to be utilized in at least one step of the surgical procedure, wherein the determination of the consequent step is based on the identity of the component, the identity of the second component, and the identity of the current step; (see at least Malackowski [0154-0158])*

#### **Claim 49**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 37. Malackowski further discloses the following limitation:

- *further comprising identifying the consequent step based on a database of user preferences; (see at least Malackowski [0072,0154-0158] Claim:14)*

#### **Claim 50**

The combination of Malackowski/Van Der Brug/DiGioia discloses all the limitations of Claim 37. Van Der Brug further discloses the following limitation:

- *a first representation is related to the current step and a second representation is related to the consequent step; (see at least Van De Berg*

*Fig: Items:4-8 & related text)*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the limitations of Van Der Brug to Malackowski/Van Der Brug/DiGioia with the motivation to provide an improved method and system for image guided multi-step medical procedure invention. (see at least Van Der Brug Column:1 Lines:50-67 Column:2 Lines:1-67 Column:3 Lines:1-47)

### ***Response to Arguments***

15. Applicant's arguments filed 26 July 2010 have been fully considered but they are not persuasive.
16. In response to applicant's initial arguments regarding independent claims 16 & 35, the Examiner points out that these claims have been substantially amended and are appropriately addressed in the current Office Action.
17. In response to applicant's arguments regarding independent claim 37 the Examiner points out that these limitations are new and are appropriately addressed in the current Office Action.
18. In response to applicant's argument that the cited prior art is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular

problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

19. In response to applicant's argument that Malackowski does not disclose the "*computer navigation system analyzes whether a tool or component for use in the surgical procedure*" in light of the cited prior art which specifically disclose these features. (see at least Malackowski [0154-0156] Fig:21 Items:350 & related text)

20. In response to applicant's argument that the Examiner fails to address "*even if the consequent step is a step other than the current step or the next step in the procedure*", the Examiner points out that his language is not in the applicant's limitations which is why it is not addressed in the Examiner's rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAJIV J. RAJ whose telephone number is (571) 270-3930. The examiner can normally be reached on Monday thru Friday 8-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

Date: 10/21/10

/RJR/

Patent Examiner Art Unit 3686

*/Gerald J. O'Connor/  
Supervisory Patent Examiner  
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